UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,889	06/25/2003	Hiroki Kobayashi	R2184.0239/P239	2305

24998 7590 04/11/2007 DICKSTEIN SHAPIRO LLP 1825 EYE STREET NW Washington, DC 20006-5403	**EXAMINER** NEWAY, SAMUEL G

ART UNIT	PAPER NUMBER
2626	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/11/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

	Application No.	Applicant(s)
	10/602,889	KOBAYASHI, HIROKI
Office Action Summary	Examiner	Art Unit	
	Samuel G. Neway	2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>29 January 2007</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>03/12/07</u>.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   This is in response to the Amendment filed January 29, 2007.

2.   Claims 1 – 9 are pending and are considered below.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4.   Claims 1 – 9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1 – 9 are directed to acquiring and producing computer files; however, they do not result in a physical transformation nor do they appear to provide a useful, concrete, and tangible result. Specifically, the claims do not appear to produce a tangible result because merely acquiring and producing computer files is nothing more than a thought or a computation within a processor. They fail to use or make available for use the result of the interpretation to enable its functionality and usefulness to be realized. The practical application is not explicitly recited in the claims nor does it flow inherently therefrom. Therefore, claims 1 – 9 are non-statutory.

On the other hand, installing software using the acquired and produced files will produce a useful, concrete, and tangible result.

Also, claims 6 – 9 are directed to a "processor readable medium" which, in accordance with Applicant's specification, may be "a transition medium". This subject

matter is not limited to that which falls within a statutory category of invention because it

is not limited to a process, a machine, a manufacture, or a composition of matter.

Instead, it includes a form of energy, which does not fall within a statutory category.

Amending the claims to recite a 'processor readable recording medium' would

overcome this rejection in a manner consistent with Applicant's specification.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6.   Claims 1 – 9 are rejected under 35 U.S.C. 102(e) as being anticipated by

Machida (US PGPub 2002/0083131).

Claim 1: Machida discloses a software-installing method for installing software in

a computer so as to use one of a plurality of printing devices connected the computer

through a network (see [0004]), the method comprising the steps of:

acquiring a template of a scenario which is a file describing procedures for

installing the software, the template including parameters ("acquires driver setup

information", [0051], see also FIG. 2, item s202);

acquiring data corresponding to the parameters("property information list is

transmitted to a pc", [0064] – [0066], see also FIG. 2, steps s204 - s206) by searching

an installation database ("property information may be stored in a registry", [0053]), and

wherein said searching is based on said computer or a user of said computer ("driver

information structure includes a PC name, ..., a user name, ...", [0052], FIG. 3 and

related text);

and producing the scenario which is specific to said computer by incorporating

the acquired data into the parameters of said template ("update the driver in accordance

with the acquired property information ", [0073], see FIG. 2, step s208 and FIG. 7, step

s607).

Claim 2: Machida discloses the software-installing method as claimed in claim 1,

further comprising a step of inputting the produced scenario to an installation program

(see [0073], [0096]-[0097]).

Claim 3: Machida discloses the software-installing method as claimed in claim 1,

further comprising a step of acquiring the data corresponding to the parameters from

the installation database located outside said computer ("managed in a centralized

fashion by the server device") (see [0074]).

Claim 4: Machida discloses the software-installing method as claimed in claim 1,

further comprising a step of acquiring data regarding print setting information as data

for said parameters from said installation database (see [0096]).

Claim 5: Machida discloses a software-installing method for installing software

computers so as to use a plurality of printing devices connected the computers through

a network ([004]), the method comprising the steps of:

producing a template of a scenario which is a file describing procedures for

installing the software, the template including parameters, and providing said template

to each of said computers (see [0068] and figure 7, [0095] and figure 23);

and producing scenarios, specific to each of said computers, based on the

produced template (see [0073], [0096]-[0097]).

Claim 6: Machida discloses a processor readable medium storing program code

means for causing a computer to install therein software to use one of a plurality of

printing devices connected the computer through a network ([004]), the medium

comprising:

program code means for acquiring a template of a scenario which is a file

describing procedures for installing the software, the template including parameters

("acquires driver setup information", [0051], see also FIG. 2, item s202);

program code means for acquiring data corresponding to the parameters

contained in the template ("property information list is transmitted to a pc", [0066], see

also FIG. 2, item s206) by searching an installation database ("property information may

be stored in a registry", [0053]), and wherein said searching is based on said computer

or a user of said computer ("driver information structure includes a PC name, ..., a user

name, ...", [0052], FIG. 3 and related text);

and program code means for producing the scenario which is specific to said computer by incorporating the acquired data into the parameters of said template ("update the driver in accordance with the acquired property information ", [0073]).

Claim 7: Machida discloses the processor readable medium as claimed in claim 6, further comprising program code means for inputting the produced scenario to an installation program (see [0073], [0096]-[0097]).

Claim 8: Machida discloses the processor readable medium as claimed in claim 6, further comprising program code means for acquiring the data corresponding to the parameters from the installation-database located outside said computer ("managed in a centralized fashion by the server device") (see [0074]).

Claim 9: Machida discloses the processor readable medium as claimed in claim 6, further comprising program code means for acquiring data regarding print setting information as data for said parameters from said installation database (see [0096]).

Response to Amendment

7.   The rejections of claims 1 – 9 under 35 U.S.C § 112 in the last Office Action have been withdrawn in view of Applicant's corrections.

Response to Arguments

8.   Applicant's arguments filed on 09/13/2006 have been fully considered but they are not persuasive.

Applicant argues that Machida fails to disclose or suggest the step of acquiring data corresponding to the recited parameters by searching an installation database, "wherein said searching is based on said computer or a user of said computer". However, Machida discloses the "driver information structure includes a PC name, ..., a user name, ..."(Machida, [0052], FIG. 3 and related text);

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel G. Neway whose telephone number is 571-270-1058. The examiner can normally be reached on Monday - Friday 8:30AM - 5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R Hudspeth can be reached on 571-272-7843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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